

OCT 12 2006

REMARKS/ARGUMENTS

The outstanding Office Action rejects claims 1-3, 6, and 10-20 on various grounds and over several applied references (*Kung et al.* (USPN 6,636,910 hereinafter "*Kung*"), *Forrer, JR* (US Pat Publ 2003/019889 hereinafter "*Forrer*"), *Mittal et al.* (USPN 5,719,800 hereinafter "*Mittal*"), and *Schmidt et al.* (USPN 7,002,884 hereinafter "*Schmidt*"). Claims 4, 6, 10, 11, & 20 are cancelled herein. Claims 1, 5, 7, and 12-14, and 19 are amended. The various ground of rejections are discussed below. The specification and various drawings are amended herein. Claims 1-3, 5, 7-9, and 12-19 are now pending in this application.

Rejections Under 35 U.S.C. § 102

Claims 10-11, 13, and 20 have been rejected under 35 U.S.C. § 102(b) as being anticipated by *Kung*.

As to Claims 10, 11, and 20, these claims have been cancelled thereby obviating the need to discuss the claims in detail.

As to Claim 13, this claim is now made dependent from Claim 12 which is not rejected under 35 U.S.C. § 102. Accordingly, this amendment overcomes the anticipation rejection based on *Kung*. Accordingly, the applicants respectfully request that this ground of rejection be withdrawn as to Claim 13.

Rejections Under 35 U.S.C. § 103

Claims 1-3 and 6 stand rejected under 35 U. S. C. §§ 103(a) as being unpatentable over *Forrer* in view of *Mittal*.

As to Claim 6, this claims is cancelled, thereby obviating the need to further discuss Claim 6.

As to Claims 1-3, these claims are amended (directly as is the case of Claim 1 or indirectly) to include the limitations of Claim 4 have been incorporated into Claim 1. The Applicants agree with the Examiners expressed opinion that Claim 4 was allowable.

Atty. Dkt. No. APL1P303/P3263

App. No. 10/800,258

Page 6

Accordingly, it is now believed that due to the amendment of Claim 1 to include these same limitations, that it is now allowable.

Claim 12 is rejected under 35 U. S. C. §§ 103(a) as being unpatentable over *Kung* in view of *Forrer*.

Upon a close reading of this rejection, the Action states that the cited art does not teach "power consumption is reduced by suspending offline diagnostic activities". It is offered that *Forrer* teaches such a limitation at paragraph [0035] (See, page 6 of the Office Action). However, the applicants respectfully point out that the cited portions of *Forrer* do not teach suspending offline diagnostic activities as required by the claim. In fact [0035] discloses more the opposite. It teaches temperature detection, error reporting, the implementation of SMART rather than shutting down diagnostics the cited paragraph teaches turning on and implementing the indicated SMART diagnostics. Thus, the cited art does not teach all of the limitations of Claim 12. Accordingly, the asserted references fail to establish a *prima facie* case of obviousness as the Claim 12. Therefore, applicants respectfully request that this ground for rejecting Claim 12 be withdrawn.

Effects of the amendment to Claim 12

Claim 12 is amended. The amendment is merely an incorporation of the base an intervening Claims 10-11 and so does not change the scope of the claims. Additionally, at the end of the claim a typographic error (the misspelling of "activities") is corrected. Thus, it is pointed out that in all essential respects Claim 12 is unamended.

Claims 14-19 are rejected under 35 U. S. C. §§ 103(a) as being unpatentable over *Forrer* in view of *Schmidt*.

Claims 14-19, as now amended, all depend (directly or indirectly) upon Claim 12. Claim 12 is believed to be allowable for at least the reasons expressed immediately above. Accordingly, the applicants respectfully offer that the cited art no longer reads on the claims. Therefore, applicants respectfully request that this ground for rejecting Claims 14-19 be withdrawn.

Accordingly, the applicants respectfully submit that the remaining pending claims rejected under §103 now define over the cited art. Accordingly, applicants respectfully request that the pending grounds for rejecting Claims 1-3, 12, and 14-19 be withdrawn.

Claim Objections:

Claim 4, 5, and 7-9 are deemed allowable if amended into independent form.

The limitations of Claim 4 have been incorporated into Claim 1. Thus, it is now believed that Claim 1 and all claims depending therefrom (Claims 2, 3, & 5) are allowable. Claim 4 was cancelled for consistency.

The limitations of Claim 6 have been incorporated into Claim 7. Thus, it is now believed that Claim 7 and Claim 8 & 9 which depend therefrom are allowable.

Moreover, the underlying art is believed to be insufficient for the reasons discussed above with respect to the other claims.

Conclusion:

In view of the foregoing amendments and remarks, it is respectfully submitted that the claimed invention as presently presented is patentable over the art of record and that this case is now in condition for allowance.

Accordingly, the applicant requests withdrawal of all pending rejections and requests reconsideration of the pending application and prompt passage to issuance. As an aside, the applicant clarifies that any lack of response to any of the issues raised by the Examiner is not an admission by the applicant as to the accuracy of the Examiner's assertions with respect to such issues. Accordingly, applicant specifically reserves the right to respond to such issues at a later time during the prosecution of the present application, should such a need arise.

As always, the Examiner is cordially invited to telephone the applicant's representative to discuss any matters pertaining to this case. Should the Examiner wish to contact the undersigned for any reason, the telephone number set out below can be used.

Additionally, if any fees are due in connection with the filing of this Amendment, the Commissioner is authorized to deduct such fees from the undersigned's Deposit Account No. 50-0388 (Order No. APL1P303).

Respectfully submitted,

BEYER WEAVER & THOMAS, LLP



Francis T. Kalinski II
Registration No. 44,177

P.O. Box 70250
Oakland, CA 94612-0250
(650) 961-8300